

REMARKS

Claims 1-6 are currently pending in the application. Applicants have canceled claims 1 and 6, amended claim 4, and added claims 7-10. Applicants request reconsideration of the application in light of the following remarks.

Information Disclosure Statement

The references listed in the Search Report are not considered material to the patent claims currently pending.

Objection to the Specification

The specification has been objected to for containing an informality. Specifically, the office action states that in

Lines 7-8 of par. 10, it's unclear as to how the water shielding part can be shaped like a sheet as the term "sheet" is typically known to describe a continuous flat material and not a shape. Further, it's unclear how the water shielding part is a sheet.

Applicants respectfully traverse this objection. Merriam Webster's online dictionary states that one definition of "sheet" is "a portion of something that is thin in comparison to its length and breadth." (<http://www.merriam-webster.com/dictionary/sheet%5B1%5D>). As can be seen from FIG. 6, included below with added comments, the backflow prevention cap 17 has a width that is relatively thin in comparison with its breadth and length. As such, the backflow prevention cap 17 is "sheet-like" by definition. In addition, the embodiment shown in FIG. 6 actually has two "widths," as can be seen, because of the "two sidewalls of the water guide slot 19a [which] are inclined to be open." (Lines 8-9 of par. 42). The two sidewalls each have a smaller width than the overall width pointed out below, but the same breadth and width—they are therefore even more "thin in comparison to [the] length and breadth" and are therefore even more sheet-like.

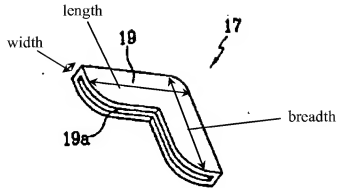


FIG. 6

(with comments and arrows added to delineate the breadth, width, and length)

Objections to Claims

The Examiner has objected to claim 6 for informalities due to improper antecedent basis. The objection is now obviated because claim 6 is currently canceled.

Rejections under 35 U.S.C. 112

Claims 1, 4, 6/1, and 6/4 stand rejected by the Examiner under 35 U.S.C. 112. The rejection of claims 1, 6/1, and 6/4 are now obviated in light of the cancellation of claims 1 and 6. With respect to claim 4, Applicants argue that this rejection is inappropriate in light of the above description of sheet-like, which is here repeated for thoroughness. Applicant notes that claim 4 has been amended only to incorporate the limitations of the now cancelled claim 1

from which it previously depended upon, except that “sheet-shaped” has been amended to “sheet-like”.

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Applicants therefore respectfully request that the rejection of claim 4 under 35 U.S.C. 112 be withdrawn.

Rejections under 35 U.S.C. 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Claims 1 and 6/1 were rejected under 35 U.S.C. 102(b) as being anticipated by Walter (U.S. Patent No. 345,089, hereinafter “Walter”). These rejections are now obviated due to the cancellation of claims 1 and 6.

Rejections under 35 U.S.C. 103

To establish a *prima facie* case of obviousness under 35 U.S.C. 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the cited prior art reference must teach or suggest all of the claim limitations. Furthermore, the suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based upon the Applicants' disclosure. A failure to meet any one of these criteria is a failure to establish a *prima facie* case of obviousness. MPEP 2143.

Claims 4 and 6/4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Brandes (U.S. Design Patent No. 385,180, hereinafter "Brandes"), in light of Lee (U.S. Patent No. 5,533,758, hereinafter "Lee"). The rejection of claim 6/4 is obviated due to the cancellation of claim 6. Claim 4 has been amended only to add the elements of claim 1 into claim 4, since claim 1 has been canceled. Applicants respectfully traverse the rejection of claim 4 and request reconsideration of the claim because Brandes and Lee are nonanalogous art to claim 4 as amended.

Lee is drawn to a "Book Cover Corner Guard," and Brandes is a design patent for a "Corner Protector." Both of these inventions fulfill the same utilitarian function, which is to protect a corner of a book or table, etc., from common wear and tear. A corner protector is needed for an item that is commonly bumped up against other items or vice versa. For instance, books are commonly opened and closed, stacked, placed on shelves, and so forth. As such, the corners are likely to be hit occasionally and rubbed against other items. This can cause common wear and tear and may cause the corner to fray and lose its original shape. Likewise, table corners can be bumped into by people, hit by chairs or other items, and so forth because there is commonly a fair amount of movement of people, chairs, and other items around table corners. This can cause the table corners to become worn and lose their original

shape and aesthetic appeal. One of the biggest reasons for protecting the corners of books and tables and such is to keep them aesthetically appealing.

A backflow cap, on the other hand, as recited in the pending claims performs an entirely different function and deals with panels that are used for the siding or roofing of a building. The portion where the backflow cap resides, of course, is entirely covered up by the panel and is not subject to the wear and tear that the Lee and Brandes devices are meant to protect against. For instance, there is generally nothing bumping into the upper corners of the panels of a roof or wall of a building because the upper corners are completely covered by other panels. Thus they are not subject to the wear and tear that Brandes and Lee are meant to protect from. Likewise, there is not generally a lot of movement of objects and people that causes bumping or rubbing against the upper corners of a panel of a roof or wall of a building. In addition, there is no need to keep the upper corners of the panels aesthetically pleasing because they are never visible but are always covered up by other panels. As such, the functions fulfilled by the Lee and Brandes devices are nowhere to be seen in Applicants' device. Nor are the functions of Applicants' device seen in the devices of Brandes and Lee.

When determining whether art is analogous or nonanalogous, courts look mostly at the "similarities and differences in structure and function." In re Ellis, 476 F.2d 1370, 1372, 177 USPQ 526, 527 (CCPA 1973) (MPEP § 2141.01(a)(II)). The present device does not have a structure that is similar to the device of Lee. For instance, Lee does not disclose two sidewalls. Nor does Lee disclose a water guide slot, or any slot for that matter. The two devices do not fulfill even slightly related functions, as described above. The device of Lee is a cover guard for a book protector, while the present device is a backflow prevention cap for a panel such as panels used on the side or roofs of houses. The devices are not trying to solve the same problem. Lee's device is attempting to protect the corners of books from being worn down, while the Applicant's device is attempting to stop the flow of water through panels attached to the roofs or sides of houses or other buildings. These fields are not even slightly related, and a practitioner having ordinary skill in the art would not look to the book protector art when trying to determine how to design a backflow prevention cap for panels to be used on

a house or building. Thus the arts are nonanalogous and Lee cannot be used for a §103 rejection.

The present device may have a structure that is somewhat similar to that of Brandes. However, as mentioned above, it is not just similarity of structure that is important but similarity of function and use. Although the structures may be somewhat similar, the functions are completely different, as also described above. The invention of Brandes is a “cover protector” and fulfills essentially the same function as the device of Lee. Brandes’ device may be used to protect a book or table corner. The dissimilarity in function of Brandes and the Applicants’ claimed device is such that Brandes is nonanalogous art. The practitioner having ordinary skill in the art would not look at the corner protector art, such as book and table corner protectors, when deciding how to design a backflow cap. This is because the functions are entirely different—one is protecting a corner from wear and tear, while the other is keeping water from leaking between panels on a roof or wall due to windy conditions. The functions are dissimilar enough that these are nonanalogous arts. As nonanalogous art, the Brandes reference cannot be used for a §103 rejection.

Applicants therefore respectfully request that the §103 rejection of claim 4 be withdrawn.

Regarding Doctrine of Equivalents

Applicants hereby declare that any amendments herein that are not specifically made for the purpose of patentability are made for other purposes, such as clarification, and that no such changes shall be construed as limiting the scope of the claims or the application of the Doctrine of Equivalents.

CONCLUSION

Applicants respectfully request that a timely Notice of Allowance be issued in this case.

If any fees, including extension of time fees or additional claims fees, are due as a result of this response, please charge Deposit Account No. 50-3545. This authorization is intended to act as a constructive petition for an extension of time, should an extension of time be needed as a result of this response. The examiner is invited to telephone the undersigned if this would in any way advance the prosecution of this case.

Respectfully submitted,

Date: __January 6, 2009__

By: __/Kenneth C. Booth/ signed _____
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